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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,623	02/22/2002	Yoichiro Tanaka	219861USOPCT	7766
22850	7590	10/19/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			FITZGERALD, MARC C	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/049,623

Applicant(s)

TANAKA ET AL.

Examiner

Marc C. Fitzgerald

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8, 9, and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 29-34 is/are allowed.
- 6) ☒ Claim(s) 8, 23-28, 35, and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Status of Application**

#### ***Response to Amendment***

The amendments filed 8 July 2005 are acknowledged. Claims 1-7 and 10-22 have been cancelled; claims 8 and 9 have been amended; and newly added claims 23-36 have been entered. Claims 8, 9, 23-36 are pending in the matter of U.S. Application No. 10/049,623.

#### ***Claim Rejections - 35 U.S.C. § 103(a)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-28, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,405,071 to Reyes in view of U.S. Patent 6,251,313 B1 to Deubzer et al.

For reasons set forth in the office action mailed 8 April 2005, the 103 rejection to claims 23-28, 35, and 36 is repeated. The substance of the rejection is provided in the Response to Arguments.

***Response to Remarks/Arguments***

To the extent of which the rejection to claims 1-7 apply, the 103 rejection to claims 9, 29-34 is withdrawn. Claims 9, 29-34 are in condition for allowance.

To the extent of which the rejection to claims 10-22 apply, the 103 rejection to claims 8, 23-28, 34, and 35 is repeated.

The Applicant's arguments have been fully considered but they are not persuasive. The Applicant's argument are summarized as the following:

1. Reyes does not describe a cosmetic.
2. The rejection is untenable because the combination of prior art provides no description or suggestion to make the modifications suggested by the Office.
3. Reyes would not have been modified or combined with Deubzer because each microcapsule specifically relates to the discovery of an optimized microparticle to deliver a material.
4. One would have been dissuaded from using the Reyes microcapsules in place of the Deubzer microcapsules because they are not suitable for cosmetic application.

In response to applicant's argument that Reyes is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the product and process as claimed in Reyes describe a rupturable microcapsule

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comprising an outer hydrophobic polymer layer grafted onto a gelled hydrophilic polymer containing an encapsulated polar solution. The instant application describes a similar product for use as a cosmetic preparation comprising a water containing powder composition with aqueous gel cores made from a water-soluble gellant coated with hydrophobic particles.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the term cosmetic preparation is a generic term. And although the product in Reyes has a different utility, the product and the essential components are the same in the instant and prior art inventions. Thus the application of Reyes to the instant invention as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art of microencapsulation.

In response to applicant's argument that Reyes would not have been modified or combined with Deubzer because each microcapsule specifically relates to the discovery of an optimized microparticle to deliver a material, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly

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suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that one would have been dissuaded from using the Reyes microcapsules in place of the Deubzer microcapsules because they are not suitable for cosmetic application, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant's amendment necessitated the recitation of the 103 rejection to claims 8, 23-28, 34, and 35 in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc C. Fitzgerald whose telephone number is (571) 272-8510. The examiner can normally be reached on 8:30 AM - 5:00 PM (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc C. Fitzgerald  
Examiner  
Art Unit 1615

October 6, 2005

 THURMAN K. PAGE  
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